

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* SUSAN G. KATZ
9

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11 Appeal 2007-3309
12 Application 10/647,618
13 Technology Center 3600
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16 Decided: November 26, 2007
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20 *Before:* WILLIAM F. PATE, III, TERRY J. OWENS and
21 STEVEN D.A. McCARTHY, *Administrative Patent Judges.*
22
23 McCARTHY, *Administrative Patent Judge.*
24

25 DECISION ON APPEAL

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27 STATEMENT OF THE CASE

28 The Appellant appeals under 35 U.S.C. § 134 (2002) from the final
29 rejection of claims 1-12 and 14-23. We have jurisdiction under 35 U.S.C.
30 § 6(b) (2002).

1 Independent claim 1 is representative of the Appellant's claims and
2reads as follows:

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4 1. A decorative external curtain assembly for
5 applying fabric material to an external facade of a
6 building, the assembly comprising:
7 a sheet of fabric material;
8 complementary engageable fastener strips
9 for respectively fastening the fabric material to the
10 external façade of the building; and
11 an attachment arrangement for attaching one
12 of the complementary engageable fastener strips to
13 the building and another of the complementary
14 engageable fastener strips to the fabric material;
15 and

16 wherein the complementary engageable
17 fastener strips are made of a pair of strips, one strip
18 having co-acting miniature hooks formed of a
19 relatively rigid filament material and another of the
20 strips having loops also formed of a relatively rigid
21 filament material which engage one another to
22 form a bond between the building and the fabric
23 that is broken by pulling apart the pair of strips;
24 and

25 wherein the complementary engageable
26 fastener strips fasten the fabric material to the
27 external façade along an entire edge of the fabric
28 material.
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30The appealed claims are rejected under 35 U.S.C. § 103(a) as being
31unpatentable over Hillstrom (U.S. Patent 5,040,586) in light of Phillips (U.S.
32Patent 5,074,348).

33 We affirm.

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ISSUE

2 The sole issue in this appeal is whether the Examiner erred in
3contending that the substitution of hook-and-loop material as taught by
4Phillips into a system for holding and displaying a banner as taught by
5Hillstrom would have been obvious.

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FINDINGS OF FACT

8 The record supports the following findings of fact (“FF”) by a
9preponderance of the evidence.

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11 1. Hillstrom discloses a system for holding and displaying a
12banner on an exterior surface of a building. (Hillstrom, col. 1, ll. 5-7; col. 2,
13ll. 55-68). The banner may be made from vinyl material, plastic material or
14any “appropriate material.” (Hillstrom, col. 3, ll. 23-31). The parties do not
15dispute the Examiner’s contention that the “appropriate material” for the
16banner may be a sheet of fabric material. (See Office Action, Jan. 13, 2005
17at 2). Hillstrom’s system uses a “frame device” which suspends the banner
18on hooks between an extruded aluminum base member screwed or nailed
19into the building surface and an extruded aluminum cover member biased
20over the free ends of the hooks. (Hillstrom, col. 4, l. 59 –col. 5, l. 3 and col.
214, ll. 8-14). Hillstrom states that the system “allows relatively quick and
22easy changes of the banners.” (Hillstrom, col. 1, ll. 51-56).

23 2. The Examiner found that “Hillstrom discloses a banner attached
24to the exterior of a building, the banner being made of ‘any appropriate
25material,’ which clearly includes a fabric. The banner is removably attached
26so that it can be changed easily, column 2 lined [*sic*, lines] 29-33. It is

1attached to an eave at the roof line of a fast food restaurant. What is not
2shown are the hook and loop fasteners.” (Office Action, Jan. 13, 2005 at 2).
3Although the Appellant expressly agreed that “Hillstrom fails to disclose the
4use of hook and loop fasteners for attaching a banner to the exterior of a
5building” (Br. 6), the Appellant did not traverse the Examiner’s other
6findings as to the scope and content of Hillstrom.

7 3. Phillips teaches “a valance treatment for a window which is
8made of standard components both swags and jabot elements that can easily
9be mounted to suit almost any width of window.” (Phillips, col. 1, ll. 46-
1050). The swags are formed from textile materials. “Attachment strips”
11consisting of hook and loop tape are sewn across the top of each swag.
12(Phillips, col. 2, ll. 53-59; col. 3, ll. 1-2; and Fig. 4). The valance treatment
13is supported by a wood strip extending from a wall. A strip of hook-tape or
14loop-tape is attached to the top of the wood strip. The attachment strip sewn
15to the top edge of each swag is pressed against the hook-tape or loop-tape
16lying on the wood strip so that the swag folds over the exposed side of the
17wood strip. (Phillips, col. 3, ll. 8-24).

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PRINCIPLES OF LAW

20 A claim is unpatentable for obviousness under 35 U.S.C. § 103(a) if
21“the differences between the subject matter sought to be patented and the
22prior art are such that the subject matter as a whole would have been obvious
23at the time the invention was made to a person having ordinary skill in the
24art to which said subject matter pertains.” In *Graham v. John Deere Co.*,
25383 U.S. 1 (1966), the Supreme Court set out factors to be considered in
26determining whether claimed subject matter would have been obvious:

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Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

14*Id.*, 383 U.S. at 17-18.

15 In order to reject a claim under 35 U.S.C. § 103(a), an examiner must
16establish a “prima facie” case for obviousness. If the examiner rejects the
17claim, the applicant may submit arguments detailing reasons why the
18applicant believes the examiner failed to make a prima facie case. Once the
19examiner establishes a prima facie case, however, the claim is properly
20rejected unless the applicant submits evidence proving sufficient new facts
21such that the sum of the facts before the examiner does not to prove the
22claimed subject matter obvious. *See In re Dillon*, 919 F.2d 688, 692-93
23(Fed. Cir. 1990) (*en banc*).

24 An examiner cannot establish a prima facie case that a claim is
25obvious “merely by demonstrating that each of its elements was,
26independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127
27S.Ct. 1727, 1741 (2007). Since not every combination of prior art references
28which happens to show each of the elements recited in a claim will suffice to
29establish a prima facie case for obviousness, the examiner must articulate
30reasons why the teachings of a particular combination suffice. That said, an

1examiner establishes a prima facie case that claimed subject matter is
2obvious when the examiner articulates reasons consistent with the level of
3ordinary skill in the art at the time of the invention why (in the words of 35
4U.S.C. § 103(a)) “the differences between the subject matter sought to be
5patented and the prior art are such that the subject matter as a whole would
6have been obvious at the time the invention was made to a person having
7ordinary skill in the art to which said subject matter pertains.”

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ANALYSIS

10 The first step in determining whether the Examiner has established a
11prima facie case for obviousness is to determine the scope and content of the
12prior art. With respect to claim 1, Hillstrom discloses a decorative external
13curtain assembly for applying a sheet of an “appropriate material” to a wall.
14The parties do not dispute that the Examiner’s contention that the
15“appropriate material” could be a sheet of fabric material. (FF 1).

16 Phillips teaches complementary engageable fastener strips (namely,
17hook-tape and loop-tape) sewn to a fabric material for engagement along an
18entire edge of the fabric material. (FF 3). The limitation of claim 1:

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20 wherein the complementary engageable fastener
21 strips are made of a pair of strips, one strip having
22 co-acting miniature hooks formed of a relatively
23 rigid filament material and another of the strips
24 having loops also formed of a relatively rigid
25 filament material which engage one another to
26 form a bond between the building and the fabric
27 that is broken by pulling apart the pair of strips
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1merely describes the structure and predictable operation of such hook tape
2and loop tape. The parties do not dispute the Examiner's contention that the
3use of hot glue or another adhesive for attaching lightweight materials such
4as hook-and-loop material to solid surfaces such as the external facades of
5buildings was within the level of ordinary skill in the art. (*See Office*
6*Action*, Sept. 22, 2005 at 2-3).

7 The second step in determining whether the Examiner has established
8a prima facie case for obviousness is to ascertain the differences between the
9prior art and the claims at issue. The only differences between Hillstrom's
10system and the subject matter of claim 1 is that, in the assembly of claim 1, a
11fastener strip of hook-and-loop material sewn across an entire edge of a
12fabric material and another fastener strip adhered to the building surface are
13used to fasten the fabric material to the building surface. (FF 2). The
14fastener strips and their attachment arrangement are taught or suggested by
15Phillips.

16 The third step in determining whether the Examiner has established a
17prima facie case for obviousness is to resolve the level of ordinary skill in
18the art. The factors which may be considered in determining the level of
19ordinary skill include the teachings of the prior art references themselves;
20the education and experience of the inventor; and the sophistication of the
21technology. *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed.
22Cir. 2007). The Appellant does not contest that hook-and-loop material
23predictably creates temporary bonds which are easily broken by pulling
24apart the hook and loop tapes. (Specification 3). The Appellant's
25background suggests that one skilled in the art would have had
26"considerable experience with regard to the use of textiles and fabrics as

1articles of manufacture” (Rule 132 Affidavit, Nov. 2, 2004, ¶ 2). Given this
2level of experience and the well-known prevalence of hook-and-loop
3material in garments and other textile products, one skilled in the art would
4have recognized that hook-and-loop material could be used to fasten fabric
5materials to substrates and that fabric materials fastened by hook-and-loop
6material could be easily detached. (FF 4). Given the relatively
7unsophisticated nature of the technology, one skilled in the art would have
8had the capacity to use hook-and-loop material to hold and display a fabric
9material against an external facade of a building.

10 The final step in determining whether the Examiner has established a
11prima facie case of obviousness is to determine whether the Examiner
12articulated reasons why the differences between the subject matter sought to
13be patented and the prior art are such that the subject matter as a whole
14would have been obvious to a person having ordinary skill in the art. The
15reasons for combining the teachings of the prior art may arise from the
16nature of the combination itself. For example, a simple substitution of one
17known element for another according to a known method to obtain
18predictable results is prima facie unpatentable. *KSR*, 127 S.Ct. at 1740.

19 In the present case, it would have been obvious to substitute hook-
20and-loop material sewn to a fabric material for engagement along an entire
21edge of the fabric material as taught by Phillips into a system for holding
22and displaying the fabric material on an exterior building surface as taught
23by Hillstrom. Phillips taught that hook-and-loop material could be used to
24hang a sheet of fabric material indoors. Substituting the hook-and-loop
25material of Phillips for the “frame device” of Hillstrom would not change
26the manner in which the hook-and-loop material fastened the fabric material

1to the building surface—the substitution would merely move the hook-and-
2loop material from an indoor location to an outdoor location. As such, the
3results of the substitution would have been predictable. These reasons alone
4suffice to establish a prima facie case that the subject matter of the claim 1
5was obvious.

6 The Appellant argues that a passage in Hillstrom criticizing “known
7systems and devices” as unreliable, particularly when “placed outdoors
8where they are subject to high winds and other harsh conditions” (Hillstrom,
9col.1, ll. 32-34) teaches away from the substitution of hook-and-loop
10material for the “frame device” disclosed in Hillstrom. (Br. 8-9). The
11Examiner correctly observed that Hillstrom does not criticize the use of
12hook-and-loop material specifically to hold and display banners outdoors.
13(Ans. 4-5). The Examiner also observed that substituting hook-and-loop
14material as taught by Phillips for the “frame device” disclosed by Hillstrom
15in an outdoor display would “render changing of the banner easier.” (Ans.
163; *compare* Specification 3 (stating that hook-and-loop material creates
17temporary bonds that are easily broken by pulling apart the hook-and-loop
18strips) *with* Hillstrom, col. 5, ll. 41-63 (describing sequence of steps required
19to change a banner held in Hillstrom’s “frame device.”)). Hillstrom does not
20teach away from the claimed subject matter because the reference’s criticism
21of “known systems and devices” is not specific enough to have discouraged
22one skilled in the art motivated to use hook-and-loop material to simplify the
23changing of outdoor banners.

24 The Appellant further argues that the claimed subject matter was
25intended to address the problem of displaying a sheet of fabric material
26outdoors and that the alleged unreliability of hook-and-loop material renders

1it unsuitable to solve this problem. In support of this argument, the
2Appellant cites *In re Wright*, 848 F.2d 1216, 1219 (Fed. Cir. 1988) for the
3proposition that “the question posed, is whether what the Appellant did
4would have been obvious to one of ordinary skill in the art *attempting to*
5*solve the problem upon which the inventor was working.*” (Br. 11 [emphasis
6added]). This proposition does not represent the current state of the law. *In*
7*re Translogic Tech., Inc.*, Appeal No. 2006-1192 slip op. at 18-19 (Fed. Cir.
8Oct. 12, 2007); *see also In re Dillon*, 919 F.2d 688, 693 (Fed. Cir. 1990) (*en*
9*banc*) (overruling *Wright* at least in part). The subject matter of claim 1
10consists of known elements combined in a known manner yielding
11predictable results. This rationale suffices to establish *prima facie*
12obviousness.

13 The Appellant submitted a “Rule 132 Affidavit” declaring that, in the
14Appellant’s experience,

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16 the idea that [hook-and-loop] tape could be
17 effectively used to attach a curtain to the outside of
18 a building where the curtain is subjected to harsh
19 environmental conditions is unexpected because
20 the general opinion in the art is that [hook-and-
21 loop material] would form too weak a bond to
22 effective [*sic*] hold the banner or curtain to the
23 exterior of the building when harsh environmental
24 conditions such as wind and rain are encountered
25 by the exterior curtain.
26

27(*Id.*, ¶ 7). The Appellant’s opinion regarding the legal issue of whether the
28differences between the claimed subject matter and the prior art would have
29been obvious to a person having ordinary skill in the art is not evidence in
30the case. *In re Lindell*, 385 F.2d 453, 456 (C.C.P.A. 1967). To the extent

1that the Appellant sought to offer opinion testimony regarding the level of
2skill in the art or to establish “unexpected results” as secondary evidence of
3non-obviousness, the Appellant’s opinion testimony does not overcome the
4strong prima facie evidence proving the obviousness of claim 1. *See id.*;
5*Leapfrog Enterps., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir.
62007).

7 On the record before us, the Appellant has not rebutted the
8Examiner’s prima facie case that the subject matter of representative claim 1
9was obvious. Since the Appellant did not separately argue the patentability
10of claims 3 and 6-21, those claims fall with claim 1.

11

12 CONCLUSION OF LAW

13 On the record before us, the Appellant has not shown that the
14Examiner erred in rejecting the claims 1, 3 and 6-21 as being unpatentable
15over Hillstrom in light of Phillips.

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17 DECISION

18 The Examiner’s rejection of claims 1, 3 and 6-21 is affirmed.

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20 AFFIRMED

21JRG

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